

### REMARKS

Claims 1-5 and 7-9 are pending. Support for claim 9 can be found at page 6, lines 15-18, of the specification. No new matter has been added.

Applicant has withdrawn Claim 8 from consideration, but requests rejoinder of such claim upon an indication that Claim 1 is allowable (see MPEP 821.04(b)).

Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Simpson et al. (USP 5,047,040). Applicant respectfully traverses this rejection.

To anticipate a claim, a reference must teach every element of the claim (MPEP 2131).

Simpson et al. teaches a catheter that uses a distal cutter to remove atherombas and the like. The Examiner argues, referring to Figs. 6 and 7, that the second drive cable (116) and the anchor member (126) correspond to the flexible shank and the burr of the cutting tool of the present invention; the flexible tubular member (102) to the tubular sheath; the first drive cable (112) to the interposed member; the drive shaft (150) to the first section of the shank; and the other part of the second drive cable (116) to the second section of the shank.

The elongate tube portion of the sheath of the present invention is clearly defined to be malleable and deformable (see Claim 1). That is, this portion of the sheath can be shaped into a desired shape, which shape is maintained in the absence of external force.

However, Simpson et al. merely teaches that the flexible tubular member (102), which is alleged to correspond to the sheath of the present invention, is flexible. There is no disclosure in this reference that the tubular member (102) is malleable and can be shaped into a desired shape, which shape is maintained in the absence of external force.

Thus Simpson et al. does not disclose this important malleability feature of the present invention.

Moreover, the handpiece of the present invention having a malleable tube portion can be advantageously manipulated into a position allowing the operator to observe the tip of the cutting tool, while also allowing smooth rotation of the cutting tool, thereby facilitating surgery (see, e.g., specification page 10, lines 9 to 20, and page 12, line 25, to page 13, line 6). Simpson et al. fails to provide a reason to employ this advantageous malleability feature.

Further, the device (100) disclosed in Simpson et al. is a catheter, so that the drive shaft

(150), which is alleged to correspond to the first section of the shank of the present invention, is not chucked in a handpiece body connected to the sheath, but is connected to a separate motorized drive unit.

Therefore, the present invention is not anticipated by, and would not have been obvious in view of, Simpson et al.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al. in view of Brown (USP 6,514,258). However, as discussed above, Simpson et al. does not teach or suggest the inventive features of the present invention as set forth in claim 1, from which claim 4 depends. Thus, the present invention set forth in claim 4 is not obvious over Simpson et al. in view of Brown.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al. The Examiner argues that wherein the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. However, claim 7 depends from claim 1, of which subject matter is not taught or suggested in Simpson et al., as discussed above. Also, a particular variable must first be recognized as a result-effective variable, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation (MPEP 2144.05 II.B.). Since the malleability property is not disclosed in Simpson et al., there is no motivation suggested therein for determining the optimum value of the tube portion material and wall thickness to achieve such property. Therefore, claim 7 is not obvious over Simpson et al.